IN THE

Supreme Court of the United States

OCTOBER TERM, 1941.

No. 219

R. PICARD, INDIVIDUALLY AND AS ADMINISTRATRIX OF THE ESTATE OF MARTIN SCHENK, DECEASED, ET. AL.,
Petitioners,

vs.

UNITED AIRCRAFT CORPORATION,
Respondent.

PETITION FOR THE WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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To the Honorable Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioners, R. Picard, individually and as administratix of the estate of Martin Schenk, deceased, Jack Sommers and John E. Johnson, respectfully pray for the writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit to review a judgment entered by that Court on May 28, 1942 (R. 1038).

Jurisdiction.

Jurisdiction is conferred by U. S. Code, Title 28, Sec. 347 (Sec. 240 of the Judicial Code), and U. S. Code, Title 28, Sec. 350, the writ being applied for "within three months."

Summary and Short Statement.

This is a patent infringement suit, but not an ordinary one. As petitioner construes the Circuit Court of Appeals' opinion, a controlling reason for its holding the patent in suit invalid on the ground of non-invention was that the Supreme Court through "**a pronounced new doctrinal trend**" **has "shown an increasing disposition to raise the standard of originality necessary for a patent.**" That there is such trend or that the fundamentals of our patent system respecting the quality of inventive thought has been in anywise changed over what they have been for long years, the petitioners deny.

The suit was originally instituted by Schenk, the patentee, and his co-owner, Picard, against United Aircraft Corporation (R. 4), manufacturer of air-cooled, radial, internal combustion engines for airplanes, particularly the Pratt and Whitney engines commonly known as the Hornet and the Wasp. The death of the patentee and division of ownership occasioned changes in the parties, here not material (R. 1035).

The patent in suit (Schenk, Reissue 21,031, R. 173) discloses a completely automatic lubricating system for the valve gear of air-cooled, radial* engines such as are generally used in airplanes. The system is not applicable to engines of other types.

Claims involved are 3, 4, 14 (original claims), 17, 18, 19, and 20 (reissue claims).

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* In a radial engine, the multiple cylinders surround the crank case, projecting radially therefrom in all directions in a single plane, with the valve gear at the outer ends of the cylinders all isolated from each other in widely separated relation and disposed of at many different angles and different elevations. Such an engine is to be distinguished from those in which the cylinders are arranged together in horizontal or V banks (in-line type engines) or in which the cylinders, though radially arranged, revolve about the central axis (rotary engines).

In any internal combustion engine, valves are provided to admit the charge and to exhaust spent gases. The valves are opened and closed by cam followers, push rods, and rocker arms, collectively known as the valve gear.

The problem of valve gear lubrication in an in-line type engine, wherein the valve gear are housed together in one or two long horizontal rows and are drained by gravity and so exhaust the spent oil, is simple. In a radial engine with no two cylinders in the same position, and all the valve gear necessarily separated from each other, with some above, some below, and others at the sides of the crank case, all in individual rocker arm boxes, other means must be employed.

The contribution of Schenk was the supplying of these means, the curing of the vital defect in an earlier tried automatic lubrication system, which because of the defect had been abandoned in favor of manual lubrication. In short, Schenk made the first successful automatic lubrication system for the valve gear of radial engines. It was an advance in the art of vast practical importance. With hand lubrication the motor would run for only ten hours without undue wear (D. C., R. 970). This period was extended by a "one-shot" pump operated by the pilot while in flight (D. C., R. 970). With Schenk's contribution an engine will run from one overhaul period to another (R. 138). It is a necessary feature for certainty of long sustained flights.

The Circuit Court of Appeals, in reversal of the District Court, found lack of invention, stating (R. 1045-46):

> **"We cannot, moreover, ignore the fact that the Supreme Court, whose word is final, has for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent. In this we recognize 'a pronounced new doctrinal trend' which it is our 'duty, cautiously to be sure, to follow not to resist.'"**

In the foregoing statement, the Circuit Court of Appeals erroneously conceived that long established principles respecting invention no longer obtain and there is a new attitude of the Supreme Court toward the standard of

invention; and thus failed to give proper heed to century-old positive tests of invention from which the Supreme Court has never deviated, to-wit:

The grant of a patent makes it presumptively valid. *Agawam Woolen Co.* v. *Jordan,* 7 Wall. 583, 589, 1869; *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.,* 220 U. S. 428, 434, 1911.

That presumption must be overcome by a high degree of proof. *Coffin* v. *Ogden,* 18 Wall. 120, 124, 1873.

That residence of invention in the patent in suit is found in the following facts—facts of a character for long years considered pertinent by the Supreme Court and still so considered as we understand it:

a. **"The defendant abandoned its use of Heron's means * * * in favor of the patentee's improved construction"** (D. C., R. 973). That upon the advent of Schenk's invention the defendant took his new teaching and abandoned the old art is persuasive of invention. *Whitely* v. *Swayne,* 7 Wall. 685, 687, 1868.

b. **Respondent's witness, the engineer Heron, clearly showed that in his abandoned automatic lubrication "there was one inherent defect which was eliminated by Schenk"** (D. C., R. 972). That what had gone before was defective, the patent curing the defect, obviates any reluctance to sustain a patent. *The Barbed Wire Patent,* 143 U. S. 275, 282, 1892.

c. **"Schenk's disclosure was indubitably an improvement"** (Opinion of C. C. A., R. 1044). **"That automatic lubrication was an important development in the art is fully demonstrated by the extent to which since its development it has superseded more primitive methods"** (D. C., R. 970). The man who makes the improvement ought not to be denied the quality of inventor. "In the law of patents it is the last step that wins." *The Barbed Wire Patent,* 143 U. S. 275, 283, 1892.

d. **"Schenk substantially advanced the art"** (C. C. A. Opinion, R. 1049). **"The substantial utility of automatic lubrication in airplanes cannot be gainsaid"**

(D. C., R. 970). One whose discovery, though only an improvement, was of substantial advantage and highly useful is entitled to a patent. *Lawther* v. *Hamilton,* 124 U. S. 1, 6-7, 1888.

e. **"Others, before Schenk, had unsuccessfully sought to achieve the same results"** (C. C. A. Opinion, R. 1049). *Webster Loom* v. *Higgins,* 105 U. S. 580, 591, 1881.

f. **Respondent "after it began to use his (Schenk's) device * * * advertised it, with fulsome praise, as a great step forward"** (C. C. A. Opinion, R. 1049). *Kryptok Co.* v. *Stead Lens Co.,* 207 Fed. 85, 95; affirmed on the same opinion, 214 Fed. 368 (C. C. A. 9); *Linville* v. *Milberger,* 29 F. (2d) 610, 613 (D. C., Kans.).

g. **Respondent tried "by stealth to buy Schenk's patent"** (C. C. A. Opinion, R. 1049). This has the same persuasive effect as bargaining for a license. *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.,* 261 U. S. 45, 56, 1923.

h. **"There had never been any complete anticipation of Schenk's method"** (C. C. A. Opinion, R. 1041). This fortifies the presumption of invention in it. *Cantrell* v. *Wallick,* 117 U. S. 689, 695, 1886.

i. **The defense of aggregation was overruled since Schenk "accomplished a better method of co-operation between the drainage means"**, etc. (D. C., R. 974-975).

j. **"The solution of drainage by gravity for automobile engines did not meet the problem involved in the radial engine of the airplane"** (D. C., R. 969).

Epitomized the story of Schenk's contribution is this:

"The nearest was the Curtiss R-1454 engine about which the evidence has very largely centered" (C. C. A. Opinion, R. 1041);

"Moreover, the defendant itself before incorporating Schenk's disclosure into its infringing engines, tried even on a commercial scale a sumpless drainage system which, like the Curtiss R-1454, depended upon direct suction on each rocker arm box. This sumpless

construction was abandoned because, in the words of the defendant's own expert, Willgoos,

> 'We found that when we shut the engine down the oil which drained out of the rocker boxes to the bottom of the engine would build up a level sufficient to overflow the valve stems so that some of the oil would find its way down the valve guides, and if the valve on that particular cylinder happened to be open it was free to flow into the combustion chamber. And if a sufficient amount of oil collected in the combustion chamber in that manner there was danger of bending a connecting rod when you started the engine, due to excessive internal pressure in the cylinder.'

"This testimony that the defendant abandoned its use of Heron's means for closing the oil circuit—an invention apparently dedicated to the public—in favor of the patentee's improved construction is indeed highly persuasive evidence that Schenk disclosed a genuine improvement over Heron which constituted useful invention. I so hold" (D. C., R. 973).

Decisions of the Courts Below.

The District Court (R. 986) held claims 4 and 14 valid and infringed; the other original claims (2, 3, 5, 11, 15, 16) not infringed; and the reissue claims (17 to 20) invalid on reissue grounds.

In finding validity, the District Court referred to the importance of automatic lubrication; its substantial utility in airplanes; the inherent defects in respondent's attempted and abandoned automatic system, and the adoption by respondent of the patentee's improved construction (R. 968-974).

The Circuit Court of Appeals held claims 4 and 14 invalid for lack of invention (R. 1049); otherwise it affirmed the trial tribunal (R. 1049).

In a concurring opinion, Judge Frank was "reluctantly

constrained" to join in the opinion of his colleagues as "far better versed * * * in passing on patents" (R. 1051). Judge Frank believed the test of invention of his colleagues to be negative (R. 1052) and that their philosophy was that invention could not result from "trial and error" and "the exercise of persistent and intelligent search for improvement" (R. 1052). He said (R. 1054):

> **"In other words, it is highly likely that only an infinitesimal percentage of so-called inventions will be patentable under Judge Hand's test, if informedly applied."**

Thus it will be seen that within the questions presented, as set forth below, there is involved the inquiry, paramount in importance to patentees, to inventors, and to the public, as to whether the Supreme Court has intended to invoke through "a pronounced new doctrinal trend a disposition to raise the standard of invention."*

Questions Presented.

The principal questions presented are:

1. Did the creation of a much needed mechanism for the automatic lubrication of the valve gear of radial airplane engines, which mechanism was found to be novel and found to have cured the vital defect in the only previous but unsuccessful and abandoned mechanism, involve invention?

2. In the consideration of the question of invention did the Circuit Court of Appeals correctly interpret the decisions of the Supreme Court within the last decade as exhibiting "a pronounced new doctrinal trend" showing "an increasing disposition to raise the standard of originality necessary for a patent"?

* Similar observations have been made by the Circuit Court of Appeals for the Sixth Circuit in *Murray-Ohio Mfg. Co.* v. *Brown Co.*, 124 F. (2d) 426, 428; *Cleveland Trust Co.* v. *Schriber-Shroth Co.*, 108 F. (2d) 109, 112; and the Circuit Court of Appeals for the Second Circuit in *Buono* v. *Yankee Maid Dress Corp.*, 77 F. (2d) 274, 276.

Subsidiary questions are:

3. Are claims of a patent, which more specifically define an invention within the disclosure of the specifications than did the original claims, invalid as reissue claims?

4. Are the claims in issue infringed?

REASONS RELIED UPON FOR ALLOWANCE OF THE WRIT.

For the reasons enumerated below, the writ prayed should be granted:

I.

By Reason of the Pronouncement and Application of the Statement That Because of "a Pronounced New Doctrinal Trend" the Supreme Court Has "Shown an Increasing Disposition to Raise the Standard of Originality Necessary for a Patent", the Circuit Court of Appeals Has Decided This Case in a Way Probably in Conflict With Applicable Decisions of the Supreme Court.

The Circuit Court of Appeals erroneously generalized from the decisions of the Supreme Court in recent years in patent cases without giving due consideration to the questions raised in those cases, or the nature of the thing patented, or the prior art applicable thereto.

The Supreme Court has not indicated by direct statement that it intended to raise the standard of invention or to change its attitude in respect to the inherencies of invention in patents. It is believed that had the Supreme Court desired to initiate a standard of invention departing from century-old rules, it would not have hesitated to so state; and that hence such a sweeping and revolutionary statement that "a pronounced new doctrinal trend" exists is a faulty inference and generalization.

II.

The Question of Whether Precedents of Long Standing Have Been Superseded by "a Pronounced New Doctrinal Trend" Raising the Standard of Invention Is of Transcendent Importance to Patentees, Patent Owners, and to Public as Affecting the Very Vitals of the Patent System. It Is a Question of Federal Law Which Should Be Settled by This Court.

The issue of invention in this instance because of the prime importance of the patented device in a vital industry emphasizes the desirability of a pronouncement by this Court as to whether there has been a change in the fundamental law of patents. The statement of the Circuit Court of Appeals is of such deep and wide implication that the statement should receive either the approbation or the disapproval of the Supreme Court.

The Circuit Court of Appeals has applied an almost wholly emasculatory rule to the question of invention.

The error of the Circuit Court of Appeals for the Second Circuit, in misinterpreting the opinions of this Court respecting the quality of invention, may be followed by that Court and other courts in future decisions. Already it has been cited and followed by a District Court in the Second Circuit in the case of *Wallace, Jr., doing business as Wallace Laboratories* v. *F. W. Woolworth Company, decided June 9, 1942,* 53 U. S. P. Q. 620. We quote from the District Court's opinion in the footnote*

* "Which is not to say that to devise that new combination would necessarily constitute patentable invention under the *present dispensation* governing such matters. (See *Picard* v. *United Aircraft Corporation,* Second C. C. A., No. 244 October Term, 1941, decided May 28, 1942 (53 U. S. P. Q. 563), both the opinion of the Court and the concurring meditations.) *Apparently* (1) the restricted monopoly of patent rights is not to reward 'the exercise of persistent and intelligent search for improvement'. Such is not deemed to 'reveal the flash of creative genius' specified as requisite

To the public, to patentees, to patent owners, and to the patent bar, indeed, to judges of the Federal Courts, the question of whether there has been a revolution in the standards of invention having its genesis in the Supreme Court is of prime importance.

III.

Unless There Has Been an Intent on the Part of the Supreme Court to Raise the Standard of Invention, the Striking Down of the Schenk Patent as Wanting in Validity, Heedless of Its Substantial Advance in a Vital Industry Where Others Had Unsuccessfully Sought to Achieve the Same Result, Is So Far a Departure From Established Rules as to Warrant Intervention and Review by the Supreme Court.

Every positive test of invention applicable to this record spells validity. But as Judge Frank points out a negative test was applied which would deny invention to the product of "the exercise of persistent and intelligent search for improvement" (R. 1052).

"The startling implication of Judge Hand's yardstick for invention" is that "it is highly likely that only an infinitesimal percentage of so-called inventions will be patentable" (Judge Frank, R. 1054).

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in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84 (51 U. S. P. Q. 272).

And yet it must be recalled that genius has once been defined as the infinite capacity for taking pains. The approved approach to most unsolved problems is the studious and often plodding one, and no reliable substitute has been suggested, even though a solution thereby accomplished is not judicially deemed to attain to the status of patentable invention. Such is the *minimizing lens* supplied to a district judge for scrutinizing a patent submitted for adjudication."

Prayer.

WHEREFORE your petitioners respectfully pray that the writ of certiorari be issued to the United States Circuit Court of Appeals for the Second Circuit to the end that this cause be reviewed by this Court; that the judgment of the Circuit Court of Appeals be reversed; and that petitioners have such other and further relief as may be proper.

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